

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Miller

Appeal No. _____

Appellant: Charles A. Miller
Serial Number: 10/680,364
Filed: October 7, 2003
Art Unit: 3651
Examiner: Rakesh Kumar
Title: CARTON WITH DISPENSER
Confirmation No.: 4643
Atty. Docket No.: RWZ-78U

Cincinnati, Ohio 45202

August 10, 2009

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
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REPLY BRIEF

This Reply Brief under 37 C.F.R. § 41.41(a)(1) is in response to the
Examiner's Answer dated June 10, 2009 in the above-captioned appeal.

The Examiner's Answer appears to respond to Appellant's Appeal Brief on two fundamental grounds. The first ground deals with the concept of analogous/non-analogous art and the Examiner's belief that Appellant is asserting that Sylvie is non-analogous art. The second ground deals with Examiner's belief that Appellant is arguing intended use instead of providing a structural distinction between the claims and Sylvie. This response in the Examiner's Answer indicates that Examiner does not fully appreciate Appellant's position in regard to Sylvie. Appellant submits that the substantive issue in this appeal is whether Sylvie discloses a dispenser, dispenser portion, or dispenser opening. These terms have meaning in the context of Appellant's specification and in the context of what one of ordinary skill in the art would clearly understand.

And while Examiner may give these terms a broad meaning during examination, that meaning must be reasonable in view of the specification and the understanding of one of ordinary skill in the art. In other words, Examiner cannot arbitrarily identify a feature in a prior art reference and give it a label corresponding to a claim term so as to render a claim anticipated by the prior art reference. The interpretation provided by the Examiner must be reasonable. Appellant submits that Examiner has failed to meet that burden. More particularly, Appellant asserts that construing divisible portions (12, 18, 41) that allow the carton to collapse to a generally flat configuration as a "dispenser", "dispenser portion", or "dispenser opening" is not a reasonable interpretation. In this Reply Brief, Appellant will address Examiner's response while emphasizing the primary point identified above.

In regard to the Examiner's response to the Appeal Brief on the first fundamental ground, it appears that the Examiner has construed the Appellant's arguments made therein to assert that Sylvie is non-analogous art. In this regard, the Examiner states: "In response to applicant's argument that 'Sylvie is directed to an aspect that is far afield for what is recited in the independent claims,' is nonanalogous art..." (Examiner's Answer, p. 5). The Examiner then goes on to argue that because Sylvie discloses a blank with fold lines and perforated lines and Appellant's carton includes fold lines and perforated lines, then "it is the view of the Office that the cited reference of Sylvie is relevant and analogous art as compared to the applicant's invention." (Id. at p. 6).

Appellant respectfully submits that Examiner has not fully appreciated the arguments presented in Appellant's Appeal Brief. In this regard, Appellant's statement that the "disclosure of Sylvie is directed to an aspect that is far afield from what is recited in the independent claims" does not suggest that Sylvie is non-analogous art, but instead highlights the fact that the function and purpose of divisible portions (12, 18, 41) is significantly different and has no reasonable relation to a "dispenser", "dispenser portion", or "dispenser opening" as is recited in the independent claims of Appellant's application. Although Appellant does not waive the right to argue non-analogous art at some time in the future, should that become necessary, Appellant was not making this argument in the submitted Appeal Brief.

Notwithstanding whether Sylvie is analogous or non-analogous art, the point that was being made was that the divisible portions (12, 18, 41) and the tear lines that form same cannot reasonably be interpreted to correspond to a "dispenser",

"dispenser portion", or "dispenser opening" as is recited in the independent claims.

There are several reasons why such an interpretation is unreasonable and Appellant addressed this in the Appeal Brief, stating:

In this regard, the scored lines in the carton of Sylvie are for the purpose of easily collapsing the carton back down to a relatively flat configuration. Once the divisible portions of the carton are removed, the carton is not able to retain its shape or structural integrity as all of the attachment points have also been removed (thus allowing the carton to fall apart).

Such tear lines do not constitute a "dispenser", "dispenser portion", or "dispenser opening" as is recited in the claims. For cartons having dispensers, the goal is to provide access to the items inside the carton while simultaneously maintaining the structural integrity of the carton. Sylvie fails to disclose any such feature. Instead, the divisible portions in Sylvie are configured such that when they are removed from the carton, the carton falls apart. The carton of Sylvie is not able to retain anything inside once the divisible portions are removed therefrom. The scored lines in Sylvie would be totally inoperable as a dispenser for a carton as there no longer exists an assembled carton after the divisible portions are removed nor containers in the carton to be dispensed. How can there be a "dispenser", "dispenser portion", or "dispenser opening" when there is no carton and nothing to dispense?

In short, Sylvie is directed to the problem of breaking down cartons after they are used and not for dispensing items contained in the carton. Moreover, the structural features in Sylvie are designed and intended for that purpose and simply cannot be used as a dispenser.

(Appeal Brief, pp. 17-18).

Not only does the interpretation put forth by the Examiner result in an inoperable carton, but the interpretation is contrary to Appellant's own specification and contrary to how the claimed invention would be viewed by one of ordinary skill in the art. Appellant asserts that it is well understood that "[f]or cartons having dispensers, the goal is to provide access to the items inside the carton while simultaneously maintaining the structural integrity of the carton." (Id.). Appellant's specification is certainly in

accord with that understanding. Appellant further asserts that one of ordinary skill in the art would also have such an understanding. As Sylvie does not maintain the structural integrity of the carton after the divisible portions (12, 18, 41) have been torn therefrom, then "one of ordinary skill in the art would not view Sylvie as disclosing a dispenser, dispenser portion, or dispenser opening as recited in these rejected claims." (Id. at p. 18). The case law is clear that to be prior art under section 102(b), the reference must not only be enabling, but must put the claimed invention in the hands of one of ordinary skill in the art. *In re Donohue*, 226 USPQ 619, 621 (Fed. Cir. 1985). Sylvie simply fails in this regard.

In view of the above, Appellant submits that the arguments presented in the Appeal Brief do not stand for the proposition that Sylvie is non-analogous art, but instead Appellant's arguments are directed to the point that identifying the divisible portions (12, 18, 41) as a dispenser, dispenser portion, or dispenser opening is i) unreasonable in view of the vast differences in the function of the two; ii) unreasonable as being contrary to Appellant's own specification; and iii) unreasonable as being contrary to the understanding of one of ordinary skill in the art.

In regard to the Examiner's response to the Appeal Brief on the second fundamental ground, it appears that the Examiner has construed the Appellant's arguments made therein to assert that the intended use, and not structural differences, is what distinguishes the claims from Sylvie. (Examiner's Answer, p. 6). Appellant respectfully disagrees. In this regard, Appellant's major argument is that Sylvie fails to disclose a "dispenser", "dispenser portion", or "dispenser opening". A "dispenser", "dispenser portion", or "dispenser opening" is a structural element that is recited in each

of the independent claims. Thus, Appellant is relying on a structural difference between the claims and Sylvie. Appellant submits that Examiner's confusion regarding this point may be due to Appellant's discussion on the function of a dispenser as part of the argument relating to why it is unreasonable to construe divisible portions (12, 18, 41) as a dispenser, dispenser portion, or dispenser opening. In other words, the function of a dispenser is discussed in order to inform the meaning of the claim terms, not as the reason why the claims define over Sylvie.

In any event, it remains that Sylvie cannot perform the function of a dispenser. Once the divisible portions of Sylvie's carton are removed, the carton is not able to retain its shape or structural integrity. This is in stark contrast to a dispenser wherein access to items inside the carton is permitted while simultaneously maintaining the structural integrity of the carton.

For all the above reasons, Appellant submits that Examiner has not responded to the substantive issue as to why it is reasonable to construe the divisible portion of Sylvie as a dispenser, dispenser portion, or dispenser opening. Appellant submits that such an interpretation is not reasonable and requests that the rejections be withdrawn.

In addition to the above, it is interesting to note that the Examiner asserts "The carton of Sylvie prior to deconstruction teaches of [sic] major element found in the applicant's claims limitations." (Examiner's Answer, p. 6). Applicant submits that Examiner has applied an improper standard for rejecting a claim under 35 U.S.C. § 102. In this regard, anticipation requires that each and every element of the claimed invention be disclosed in the prior art reference. *W.L. Gore & Associates, Inc. v.*

Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851, 105 S.Ct. 172 (1984). Thus, the prior art reference must not teach the "major elements" recited in the claims, but must teach each and every element recited in the claims. For this further reason, Appellant submits that the rejections are flawed and should be overturned.

Conclusion

In conclusion, Appellant respectfully requests that the Board reverse the Examiner's rejections of all the pending claims and that the application be passed to issue. If there are any questions regarding the foregoing, please contact the undersigned at 513-241-2324. It is believed that no additional fees are due with the submission of this Reply Brief. If any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

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